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DFW 3634  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **WINCHESTER, Richard M.** )  
Filed: 08/27/01 )  
Serial No.: 09/940,208 ) Art Unit: 3634  
For: Construction Layout Stripping ) Examiner: Strimbu, Gregory  
Having a Plurality of Pairs of Uprights )  
Thereon )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO OFFICE ACTION**

The Applicant hereby respectfully responds to the Office Action dated July 29, 2004. Pursuant to the interview conducted between the Examiner and the Applicant on August 24, 2004, the comments discussed therein are also considered and addressed herein. With the amendments made to the existing claims, and the new claims submitted herewith, the Applicant respectfully submits that the application is in proper form for allowance. The Applicant asks the Examiner to allow the amended and new claims to pass to issue. The Examiner's objections will be addressed in the order they were presented in the Office Action.

The Examiner objected to claim 12 because it referred to "method" claim 12, but claim 12 did not itself set forth a method. Claims 14 is withdrawn, so that objection is moot.

Claims 1-14 were rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter thereof. The Examiner objected to the phrase "thereon on a single fixed spacing interval" as being indefinite because it is unclear what the Applicant was attempting to set forth. That phrase has been stricken from the amended and new claims. Therefore, that objection no longer applies. Similarly, the Examiner objected to the use of

the phrase "type" on line 3 of claim 2. Claim 2 has been canceled, and that phrase is not used in the new claims.

With respect to the Examiner's rejection of claims 1-6 based on Salato under 35 U.S.C. § 102, Salato does not teach or suggest that uprights defining space to grippingly engage two different sizes of construction members. The improvement is not as simple as merely adding more uprights. They have to be off-set, one from another. Salato nowhere teaches or suggests the off-setting of uprights for two different sets of spacing partitions to provide for spacing of either 2x lumber or 4x lumber on either 16 or 24 inch centers. This was a development conceived by the inventor herein, and not taught nor suggested by Salato. Therefore, the claim 12, as amended, is proper for allowance in view of Salato.

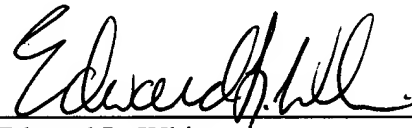
The Examiner next rejected claims 7-12 and 14 as being unpatentable over Salato in further view of Grzyb. Grzyb disclosed construction layout stripping comprising a tape having repeating units, each having a center, wherein a second unit is eight inches from the first unit and a third is eight inches from the second unit, a fourth unit is at the 32 inch mark on the tape, being 8 inches from the third unit and so on. In other words, Grzyb teaches the spacing units, but it does not teach partitions. Neither Grzyb alone or Grzyb combined with Salato teach two different sets of partitions defined by uprights adapted to grippingly receive 2x and 4x lumber on the same strip. This distinction alone is sufficient to render them different from and not obvious in view of Grzyb and Salato. It is a development that has tremendous economic potential, but neither of them taught or suggested it.

Similarly, the Examiner allowed LaFrance in view of Grzyb and Salato, and it did not teach that either. Why did the Examiner allow LaFrance if the present invention is so obvious? LaFrance was eliminated as a reference in this patent application because of a 131 Affidavit provided by the

Applicant swearing behind LaFrance. If LaFrance was allowable in view of the prior art, why is the present invention not allowable?

Neither Grzyb or Salato teach or suggest the use of two different sets of partitions to grippingly receive two different sizes of construction members spaced on two alternate sets of spacing intervals. This improvement would not have been obvious to one skilled in the art because it required off-setting the spacing intervals. If no one had taught the off-setting of the spacing intervals, with two sets of partitions directly adjacent to one another. This improvement was neither taught nor suggested, and is not obvious in light of prior art. Therefore, claims 12-18, as amended, should be allowed to pass to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Edward L. White', is written over a horizontal line.

Edward L. White  
Registration No.: 41,375  
Edward L. White, P.C.  
50 Penn Place, Suite 440  
Oklahoma City, OK 73118-1803  
Phone: 405/810-8188  
Fax: 405/842-0336  
E-mail: ed@edwhitelaw.com

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